

REMARKS

Claims 4 and 9-16 are pending.

Claims 14 and 15 have been withdrawn from consideration.

Claims 4 and 9-13 were rejected.

Claim 4 is an independent claim from which the remaining claims depend directly or through intervening claims.

Specification

A minor editorial change has been made to the Specification.

Reply to Election

In the Office Action, the Examiner stated that claims 14 and 15 were withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

While these claims are drawn to a different species as these claims are dependent claims upon the allowance of the base claim, the Examiner is requested to consider a rejoinder of these claims.

Reply to Rejections

Claims 4, 9, 10 and 13 were rejected under 35 U.S.C. 103(a) as being unpatentable over Ejima et al. (US PG-PUB No. 2002/0027602) in view of Habuto et al. (U.S. Patent No. 6,810,441). This rejection is traversed.

Base claim 4 has been amended and Ejima does not show or suggest at least the feature and function set forth in base claim 4 (amended). Also, according to the digital camera 10 disclosed

in Habuto, since deletion operation of the music file etc. is urged by displaying a message when an empty area (available capacity) of the flash memory 30 is not enough, the empty area for recording still images can be increased.

However, in the disclosure of the Habuto, deletion operation of the music file has to be performed after interruption of the image-capturing operation. That is, in the disclosure of Habuto, deletion processing of the music file and image-capturing operation together with recording processing of the captured image to the medium are not directly associated with each other.

In contrast, in the invention in the context claimed, (claim 4 amended) disclosed in Fig. 8 of the present application, deletion processing of the music file is performed in a consecutive image-capturing sequence.

The technical idea of the present invention that deletion of the music file is incorporated into the image-capturing sequence is not indicated in the cited reference Habuto.

There is no *prima facie* case of obviousness because at least there is no motivation outside of the Applicant's own disclosure as a template, to combine the features of the references to arrive at the combination claimed. Also, the features claimed are not shown or suggested by the references. While the Examiner has noted extensive parts of the secondary reference, a review of the reference does not support the Examiner's factual assertions. For example, the specific operation (function) of the control device as set forth in claim 4, last paragraph, is not shown or suggested.

Even if all the parts are known, which they are not, to focus on the obviousness of substitutions instead of the invention as a whole is improper under 35 U.S.C. 103. See *Hybritech*

Inc. v. Monoclonal Antibodies, Inc. 231 USPQ 81, 93 (Fed. Cir. 1986) wherein the court stated as follows:

Focusing on the obviousness of substitutions and differences instead of on the invention as a whole...was a legally improper way to simplify the difficult determination of obviousness.

Even if all the parts may be known does not suggest that the combination is obvious. See *Ruben Condenser Co. v. Copeland Refrigeration Corporation* which stated as follows:

We do not of course forget that it is always the combination that counts, and that no patents, or almost none, are made from new elements. 85 F.2d 537, 541, 31 USPQ 6, 6 (C.A.2 1936).

It may be that the Examiner's position is that one skilled in the art may be able to arrive at the appellant's invention because he has the necessary skills. But this is an improper reason for basing a conclusion of obviousness. See *Ex parte Levengood*, 28 USPQ 2d, 1300, 1301 (BPAI 1993) wherein the Board stated as follows:

At best, the Examiner's comments regarding obviousness amount to an assertion that one of ordinary skill in the relevant art would have been able to arrive at the appellant's invention because he had the necessary skills to carry out the requisite process steps. This is inappropriate standard for obviousness. (emphasis added)

Also, in arriving at the conclusion of obviousness, the Examiner must consider the results achieved. These results are set forth in the specification. See *The Gillette Co. v. S.C. Johnson & Son Inc.* 16 USPQ 2d 1923, 1928 (Fed. Cir. 1990) wherein the court stated as follows:

An analysis of obviousness of a claimed combination must include consideration of the results achieved by that combination. As we explained in *Interconnect Planning Corp. v. Feil*, 774 F.2d 1132, 1143, 227 USPQ 543, 551 (Fed. Cir. 1985): [cited in the MPEP]

The dependent claims are considered patentable at least for the same reasons as the base or intervening claims.

For the reasons set forth above, the Examiner is requested to reconsider and withdraw the rejection under 35 USC 103.

Second Rejection

Claims 11 and 12 rejected under 35 USC 103(a) as being unpatentable over Ejima et al. (US PG-PUB No. 2002/0027602), Habuto et al. (US Patent No. 6,810,441) and further in view of Yamaoka (US Patent No. 5,130,812). This rejection is traversed.

As explained in the Reply to the first rejection, the first two references do not establish a *prima facie* case of obviousness. The addition of Yamaoka does not cure the innate deficiencies of a rejection based on the first two references.

The feature of "shutter button" described in claim 12 states relationship between the half-pressed operation in the consecutive image-capturing sequence (operation) and the deletion operation of the music file; differs from the operation of "shutter button" in Yamaoka.

For the reasons set forth above, the Examiner requested to reconsider and withdraw the rejection of the claims under 35 USC 103.

New Claim 16

In the new claim 16, specific example of the relationship between the operation of shutter button and processing (sequence) of the camera is clarified. This feature is not shown or suggested by the references applied.

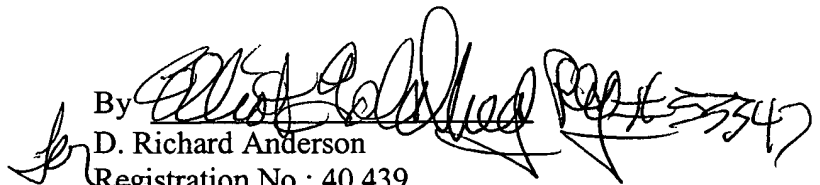
CONCLUSION

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact Elliot A. Goldberg (Reg. No. 33,347) at the telephone number of the undersigned below, to conduct an interview in an effort to expedite prosecution in connection with the present application.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

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Respectfully submitted,

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